UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,705	10/20/2000	Simon Robert Walmsley	NPA053US	7415

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER
MARC COLEMAN, MARTHE Y

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No.	Applicant(s)
	09/693,705	WALMSLEY ET AL.
	Examiner	Art Unit
	Marthe Y Marc-Coleman	3661

-- The MAILING DATE of this communication appears on th c ver she t with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 October 2000_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-12_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-12_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _20 October 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _4_ .	6) ☐ Other: .

DETAILED ACTION

1.   This is a first office action in response to Application No. 09/693,705 filed on

October 20, 2000 in which claims 1-12 are presented for examination.

Oath/Declaration

2.   The Oath/Declaration is defective because the foreign application filing date is in

error. The foreign filing date should be 25 October 1999 vice 25 October 2000.

Abstract

3.   Applicant is reminded of the proper language and format for an abstract of the

disclosure.

(a) The abstract should be in narrative form and generally limited to a single

paragraph on a separate sheet within the range of 50 to 150 words. It is important that

the abstract not exceed 150 words in length since the space provided for the abstract

on the computer tape used by the printer is limited. **The form** and legal phraseology

often used in patent claims, such as "means" and "said," **should be avoided**. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether

there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information

given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure

describes," " **The present invention in line 3** ", etc.

(b) The abstract is objected to because of the following informality:

Fig. 8 should be deleted from the abstract page. Correction is required.

Specification

4.   The specification is objected to because of the following informality:

(a)   the co-pending applications identified by their docket throughout the specification are not considered because they are improperly identified. It is suggested that the serial number of the co-pending applications be provided in response to this office action. Applicant is reminded that upon providing the corresponding serial numbers of the co-pending applications identified by their docket numbers, paragraphs on page 1, lines 14-15, 22-23, 32-33 and page 2, lines 19-20 should be deleted.

(b)   the listing of reference U.S. Patent No. 5,051,746 in the specification on page 16, line 26 is in error and should be replaced by - - 5,051,736 - - instead;

(c)   on page 7, line 5 of the specification, "of a the" should be replaced by - -of a- -;

(d)   on page 15, line 1 of the specification, delete "contains" (first occurrence).

(e)   the "Stephen B. Wicker, Error Control Systems for Digital Communication and Storage, Prentice-Hall 1995" on page 15 lines 25-27 of the specification is not considered because a copy of such document is not submitted;

(f)   the "Anoto Technology Description, Anoto April 2000" on page 18 lines 2-

3 of the specification is not considered because a copy of such document is not

submitted.

Correction is required.

Information Disclosure Statement

5.   In the Intelligent Paper listed as IDS, page 394 is missing. It is suggested that

Applicant submit the missing page in response to this office action. In light of the

missing page, the document has been considered as best understood by the Examiner.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in
> public use or on sale in this country, more than one year prior to the date of application for patent in
> the United States.

7.   Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by

Conroy et al. (U.S. Patent No. 5,686,705).

In regard to claim 11, Conroy et al. discloses a system for enabling a user to

designate, in a computer system, at least one geographic location, the system including:

-     a globe (see col. 18 lines 18-20, lines 31-34 and Figs. 11 and 12), the globe

      including coded data indicative of a plurality of reference points of the globe

      (see col. 18 lines 18-43);

- a computer system **(142)** for receiving indicating data from a sensing device

(116) operated by the user, the indicating data regarding a position of the

sensing device relative to the surface of the globe (see col. 18 lines 34-52) . The

sensing device when placed in a operative position relative to the surface of the

globe, sensing the indicating data using at least some of the coded data (see col.

18 lines 31-52);

- wherein the computer system is configured to identify, from the indicating data

the at least one geographic location (see col. 18 lines 37-51).

In regard to claim 12, Conroy et al. discloses that the sensing device sensing

its movement relative to the globe using at least some of the coded data wherein the

computer system is configured to identify, from said movement, a geographic region

(see col. 13 lines 16-18; col. 18 lines 31-52 and Figs. 11, 12).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1 -10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Conroy et al. (U.S. Patent No. 5,686,705) in view of Dymetman et al. (Intelligent Paper;

in Electronic Publishing Artistic Imaging, and Digital Typography).[1]

        In regard to claim 1, Conroy et al. discloses a method of enabling a user to

designate, in a computer system **(30 in Fig. 1)**, at least one geographic location (or

point of interest P in Fig. 2) (see col. 18 lines 44-52), the method including the steps of:

- receiving in a computer system **(which is processor 30)** indicative data from a

sensing device **(stylus 20)** operated by the user (see abstract and col. 8 lines 55-58),

the indicative data regarding the identity of the map (see Fig. 4 items 114A, 114B and

col. 12 lines 20-30) and a position of the sensing device relative to the map (which

corresponds to the position of the stylus 20 relative to the surface 10 wherein surface

10 is considered to be a map see also col. 12 lines 20-30), the sensing device when

placed in an operative position relative to the map sensing the indicating data using at

least some of the coded data (see col. 12 lines 20-22 and Figs. 2 and 4) (the

geographical location represented by a unique combination of x and y coordinates, are

coded and stored at specific addresses in the microprocessor see col. 9 line 20-23 and

col. 10 lines 56-65); and

        - identifying in the computer system and from the indicating data the at least one

geographic location **(p)** (see abstract; col. 3 lines 18-27; and col. 8 lines 55-60).

        Conroy et al. also discloses a map including coded data indicative of an identity

of the map and a plurality of reference points **Px** and **Py** of the map (whose

geographical location represented by a unique combination of x and y coordinates, are

coded and stored at specific addresses in the microprocessor (see col. 9 line 20-23 and

col. 10 lines 56-65).

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[1] The Intelligent Paper is dated March/April 1998.

Although Conroy et al. discloses a map included coded data, and a printer, Conroy et al. fails to specifically disclose printing a map, including coded data.

Dymetman et al., on the other hand, discloses printing a map of a geographic location with coded data (see page 396 section 3, Technology wherein a map of Europe is printed on Intelligent paper having two layers of ink and printed on the paper support. The first layer, is the coded layer printed in invisible ink and the second layer is printed in conventional colored inks and is visible to the user).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman e al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

In regard to claim 2, Conroy et al. discloses:

- receiving in the computer system, movement data regarding movement of the sensing device relative to the map (see col. 13 lines 16-18), the sensing device sensing its movement relative to the map using at least some of the coded data (see col. 13 lines 16-18 and col. 9 lines 2-23 and Fig. 2).

- Identifying in the computer system and from the movement data a geographical region (see col. 13 lines 16-19; col. 13 lines 53-63; and col. 18 lines 43-52).

In regard to claim 6, Conroy et al. discloses a system for enabling a user to designate, in a computer system **(30)**, at least one geographic location (which

corresponds to the point of interest see col. 8 lines 55-60; col. 10 lines 60-65; col. 18

lines 44-52), the system including:

> - a map of a geographic area (the geographical area corresponds to the surface
>
> 10 in Figs. 1 and 2) (see col. 5 lines 20-21; col. 19 lines 58-67; and col. 13, lines
>
> 59-60 also see abstract) , the geographic area including the at least one
>
> geographic location (col. 8 lines 55-60 and Figs. 1 and 2), the map including
>
> coded data indicative of an identity of the map and a plurality of reference points
>
> **Px** and **Py** of the map (whose geographical location represented by a unique
>
> combination of x and y coordinates, are coded and stored at specific addresses
>
> in the microprocessor (see col. 9 line 20-23 and col. 10 lines 56-65).
>
> - a computer system **(which is processor 30)** for receiving indicative data from
>
> a sensing device **(stylus 20)** operated by the user (see abstract and col. 8 lines
>
> 55-58) , the indicative data regarding the identity of the map (see col. 9 lines 20-
>
> 47) and a position of the sensing device relative to the map (which corresponds
>
> to the position of the stylus 20 relative to the surface 10 wherein surface 10 is
>
> considered to be a map see also col. 12 lines 20-30), the sensing device when
>
> placed in an operative position relative to the map sensing the indicating data
>
> using at least some of the coded data (see col. 12 lines 20-22 and Figs. 2 and 4)
>
> (the geographical location represented by a unique combination of x and y
>
> coordinates, are coded and stored at specific addresses in the microprocessor
>
> see col. 9 line 20-23 and col. 10 lines 56-65); and

wherein the computer system is configured to identify from the indicating data the

at least one geographic location **(p)** (see abstract and col. 3 lines 18-27 and 8 lines 55-

60).

Although Conroy et al. discloses a map included coded data, and a printer, Conroy et al. fails to specifically disclose a printer to actually print a map, including coded data.

Dymetman et al. discloses a printer for printing the map including the coded data on demand (on page 396 section 3, Technology, a map of Europe is printed on Intelligent paper wherein two layers of ink are printed on the paper support. The first layer, is the coded layer printed in invisible ink and the second layer is printed in conventional colored inks and is visible to the user).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating system because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

In regard to claim 7, Conroy et al. discloses that the sensing device sensing its movement relative to the map using at least some of the coded data; wherein the computer system is configured to identify, from said movement, a geographic region (see col. 13 lines 16-18; col. 18 lines 31-52 and Figs. 11 and 12).

In regard to claims 3 and 8, Conroy et al. discloses the map contains geographic features of the geographic area (see col. 18 lines 44-52).

In regard to claim 4, although Conroy et al. discloses that when a map control is designated to the user using the sensing device, performing, in the computer, an action

associated with the map (in col. col. 8 lines 55-60), Conroy et al. fails to specifically disclose the step of printing at least one map control.

Dymetman et al., on the other hand, discloses the step of printing at least one map control (by printing a keyboard on page 400 in the hotel reservation section). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman's map printed on intelligent paper with coded data with Conroy's position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

In regard to claims 5 and 10, Conroy et al. meets the limitations of claims 4 and 9, but fails to disclose that the action is one of printing a map of a designated geographic region.

Dymetman et al. discloses that the action is one of printing a map of a designated geographic region (see Europe map on page 396 Technology).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating method/system because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen. map.

In regard to claim 9, Conroy et al. discloses a map control page including at least one printed map control (see col. 5 lines 12-22 and col. 19 lines 55-57); wherein the computer system is configured to an action associated with the map control when

the map control is designated by the user using the sensing device (see abstract lines 22-28 and col. 8 lines 55-60).

Conclusion

10. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure:

Flowers (U.S. Patent No. 5,877,458) discloses an electrographical sensor unit and method for determining the position of a user selected position.

Babin et al. (U.S. Patent No. 5,945,985) discloses an interactive multimedia geographic system.

Mauney (U.S. Patent No. 5,214,757) discloses an interactive automated mapping system.

Redford et al. (U.S. Patent No. 5,749,735) discloses an interactive magazine.

Huber (U.S. Patent No. 4,420,682) discloses an interactive map information exchange.

Huber (U.S. Patent No. 4,445,028) discloses unidirectional code for interactive map system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marthe Y Marc-Coleman whose telephone number is (703) 305-4970. The examiner can normally be reached on Monday-Thursday from 9:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Patent Examiner
Marthe Y. Marc-Coleman
Marthe Marc-Coleman

April 20, 2002